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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,212

07/18/2003

Rickey D. Hart

022956-0233

2862

21125 7590 02/27/2009  
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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3774

NOTIFICATION DATE

DELIVERY MODE

02/27/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/623,212	HART, RICKEY D.	
	Examiner	Art Unit	
	Paul B. Prebilic	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 61-68, 75, 76, 82-84 and 95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-68, 75, 76, 82-84 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/21/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

*Claim Objections*

Claims 61, 75, 84, and 95 are objected to because of the following informalities:

In claim 61, on line 8, in claim 75, on line 6, in claim 84, on line 8 and in claim 95, on line 10, the language "the distal end of said insertion element" lacks antecedent basis.

In claim 75, on line 7, "the proximal end of the stabilizing element" lacks antecedent basis.

In claim 84, on line 8, "the proximal end" lacks antecedent basis.

Appropriate correction is required.

Upon review of the parent applications and the Applicant's remarks filed November 26, 2008, it was determined that claims 61-67, 75, 76, 82, 84 and 95 have an effective filing date of July 3, 1997. This is due to the fact that the step of pulling the insert element into the stabilizing element was first disclosed with the filing of the 08/887,580 application on July 3, 1997. Claims 68 and 83 have an effective filing date of November 21, 1997 because the subject matter set forth therein was first introduced on that date.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-68, 75, 76, 82-84, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholson et al (US 5,725,529) in view of Goble et al (US 4,870,957) in further view of Pierce (US 5,324,308) or Le et al (US 5,486,197). Nicholson discloses a method of anchoring soft tissue within bone by inserting a stabilizing element (member (10) of Nicholson), threading a suture attached to soft tissue through an aperture of an insertion element (see Figures 5, 7, and 10 as well as column 8, line 47 et seq.), and then inserting the insertion element into the stabilizing element by deformably expanding it (see column 10, lines 29-67). However, Nicholson fails to teach threading the soft tissue through the aperture. Goble teaches that it was known to thread soft tissue (37) and a suture (stint (38)) together through an aperture in a similar anchor system; see the abstract and column 6, lines 26-38. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to thread the soft tissue and suture together or the soft tissue only through the aperture of Nicholson (1) for the same reasons that Goble does the same or (2) to avoid an additional soft tissue-to-suture attachment step when one is not needed. This change would shorten and simplify the procedure.

Nicholson also fails to disclose the step of pulling the anchor into place as claimed. However, Pierce (see the paragraph bridging columns 1 and 2) or Le (see the abstract) teaches that it was known to utilize pulling forces and sutures in order to insert core elements into their outer sheaths. Therefore, it is the Examiner's position that it would have been obvious to utilize a pulling force on an insertion element in order to insert it into a stabilizing element for the same reasons that Pierce or Goble does the

same or in order to provide a second means to make the connection in additional to the first means of pushing.

With regard to claims 63 and 66, the Applicant is directed to see Figure 3.

With regard to claim 65, the Applicant is directed to see column 7, line 46 et seq.

### *Response to Arguments*

Applicant's arguments filed November 26, 2008 have been fully considered but they are not persuasive.

The Applicant argues that all present claims except claim 84 have effective filing dates of November 21, 1996; see page 5 of the response filed November 26, 2008. However, upon review of the relevant portions, the Examiner did not find support for pulling the insertion element into the stabilizing element as now claimed. Therefore, claims 61-67, 75, 76, 82, 84 and 95 have an effective filing date of July 3, 1997. This is due to the fact that the step of pulling the insert element into the stabilizing element was first disclosed with the 08/887,580 application filed July 3, 1997. Claims 68 and 83 have an effective filing date of November 21, 1997 because the subject matter set forth therein was first introduced on that date.

With regard to the traversal of the only remaining prior art rejection, the Applicant argues that the Pierce and Le teach pulling the proximal end of one element into the distal end of the other element instead of vice versa. However, the Examiner asserts that proximal and distal are arbitrary designations. The claims have not defined the terms "proximal" or "distal" with respect to other elements of the device or with respect to the hole. For this reason, the argument is considered unpersuasive.

Furthermore, with regard to the other arguments presented, the Examiner notes that Pierce and Le were only utilized to show that the concept of pulling one bone inserted element with respect to another to anchor the same was known. In other words, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### *Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending

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claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774